

Notice of Allowability

Application No.

10/748,191

Examiner

Thomas S Heard

Applicant(s)

HWANG ET AL.

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to _____.
2. ☒ The allowed claim(s) is/are 21 and 22.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

EXAMINER'S AMENDMENT

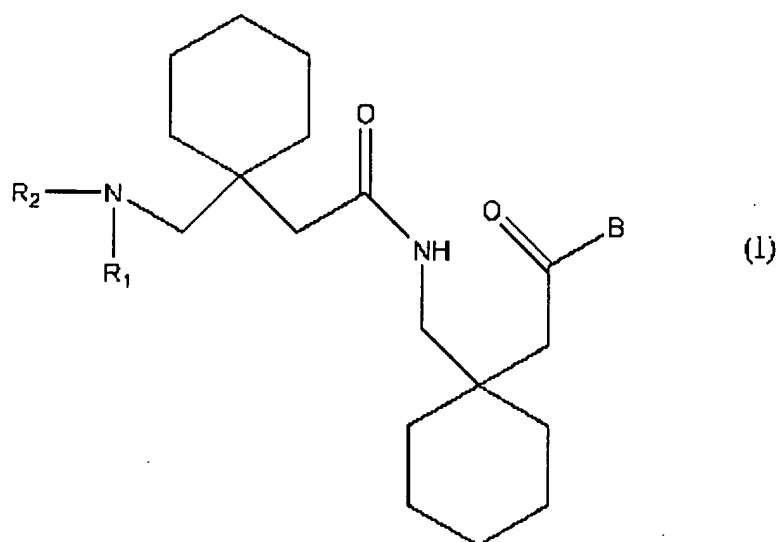
The submission of the official certified copy of the priority document in the communication on December 3, 2004 is acknowledge.

Objections to claims 1-20 are withdrawn as the applicants have canceled the claims. The U.S.C. §112 2nd paragraph rejection of claim 1 as amended by the applicant is maintained for reasons previously stated in the previous office action mailed November 3, 2004. Corrections to the amended claims appear below to address the U.S.C. §112 2nd paragraph concern.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Claim 21 (new). A compound of a formula (I):



wherein

R₁ and R₂ are independently H;

B is OR₃, wherein R₃ is H or C₂₋₅ alkyl group.

Claim 22 (new). The compound of claim 21 wherein R₃ is ethyl.

In a telephone conversation on June 10, 2005, Chung Chen (#31725) stated that the applicants have accepted the examiners amendment as written above.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance: the compound of Formula I is an analogue of Gabapentin, known in the art for treatment of epilepsy. The compound of Formula I in the instant application share similar genus with Bryans et al (U.S. 2003/0216469 A1) but the genus of Formula I is not anticipated or suggested in the prior art.

Claims 21 and 22 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas S Heard whose telephone number is (571) 272-2064. The examiner can normally be reached on 9:00 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TSH

A handwritten signature in black ink, appearing to read "Bruce Campell". The signature is fluid and cursive, with the first name "Bruce" and last name "Campell" clearly distinguishable.

**BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**



UNITED STATES PATENT AND TRADEMARK OFFICE

To: Richard E. Fichter
From: Thomas S. Heard

Please review the proposed examiner's amendment for Docket No. HWAN3031/REF. If found acceptable, please contact me at (571) 272-2064. If I am not at my desk you may leave a voice mail message and I will process the application accordingly. Thank you very much.

Respectfully,

Thomas S. Heard Ph.D
Art Unit 1654
(571) 272-2064

Attachments: Two Pages of Draft Examiner's Amendment.

PROPOSED EXAMINER'S AMENDMENT

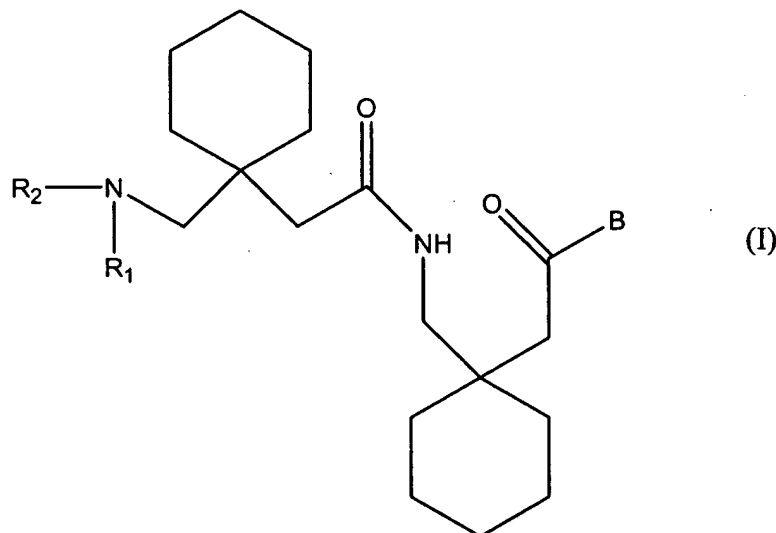
Draft

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